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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/771,798 | 02/04/2004 | Terrell B. Jones | 043474/258903 | 3348 |

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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

HERNANDEZ, OLGA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2144

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,798

Applicant(s)

JONES ET AL.

Examiner

Olga Hernandez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/04/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/31/05 have been fully considered but they are not persuasive.

Applicant argues that Bellesfield does not teach a solution set including at least one airport. In the broadest interpretation, Bellesfield teaches a solution set including at least one airport, which is the destination and/or point of interest to get a travel plan (abstract). A user selects, via the user interface, a departure point and a destination point, the routing component employs the routing database to generate and display a route between the selected departure and destination points. Based on the selected criteria by the user (destination/airport), the solution set which is the travel route generated by Bellesfield includes the airport, which is the destination and/or point of interest. Applicant argues that there is no motivation to modify Bellesfield's invention to provide a solution set including at least one airport. However, "a motivation to combine/modify which is implicit in the knowledge of one of ordinary skill in the art." *National Steel Car Ltd. v. Canadian Pacific Railway Ltd.*, 357 F.3d 1319, 1338, 69 USPQ2d 1641, 1656 (Fed. Cir. 2004). Merely using Bellesfield's invention, and entering as a destination an airport will provide a route to said destination/airport, which is the solution set. Indeed, one skill in the art has a motivation to use Bellesfield's invention and enter the airport as a destination; since, it will provide an automated travel planning from the starting/departure point to the destination.

The court found motivation to combine the references to arrive at the claimed invention in the "**nature of the problem to be solved**" because each reference was directed "to precisely the same problem of underpinning slumping foundations." *Id.* at 1276, 69 USPQ2d at 1690. The court also *rejected* the notion that "an express written motivation to combine must appear in prior art references...." *Id.* at 1276, 69 USPQ2d at 1690.

It is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

What would have been 'obvious to try' would have been to **vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result**, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave **only general guidance as to the particular form of the claimed invention or how to achieve it.**" *In re O 'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one **reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.**). See the cases cited in *O 'Farrell* for examples of decisions where the court discussed an

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improper "obvious to try" approach. See also *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) and *In re Ball Corp.*, 925 F.2d 1480, 18 USPQ2d 1491 (Fed. Cir. 1991) for examples of cases where appellants argued that an improper "obvious to try" standard was applied, but the court found that there was proper motivation to modify the references. Where in the instance case the modification is the destination (airport) entered by the user. The user is trying to get to a destination based on a travel plan (the solution). Definitely, the motivation of a user is to arrive at a predetermined place based on certain criteria as known in the navigation art (e.g. shortest route), which motivate anyone to use Bellesfield's invention and change/modify the destination based upon user's choice and/or needs.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellesfield et al (6,498,982).

As per claims 1, 7-9, 14 and 22, Bellesfield teaches:

- receiving an information request based on a flexible set of user-defined travel related criteria from a client (figures 1, 2, 9, 10 and 11);

- processing the information request to initiate at least one inquiry based on the information request and collecting a plurality of responses from an information server, which gathers information from at least one remote server, to determine a solution set to the information request (figure 2);
- rendering the solution set unto an electronic map overlay for transmission to the client (figures 2 a1,14 1).

Bellesfield does not teach the solution set includes at least one of at least one airport, at least one airfare and at least one distance between at least one pair of airports. However, it would have been obvious to one skill in the art to include at least one airport in Bellesfield's invention in order to get a travel plan and using it as a destination and/or point of interest.

As per claims 2 and 10, Bellesfield teaches at least one server and a computer system (column 5, lines 5-9).

As per claims 3 and 11, Bellesfield teaches a human being on the client and pre-selected at least in part by topic by client (abstract).

As per claim 4, Bellesfield teaches a plurality of inquiries for querying a plurality of data tables (figures 3, 5 and 7).

As per claims 6 and 12, Bellesfield teaches the solution set to the user that posed the information request (figures 10 and 11).

As per claims 5 and 13, Bellesfield teaches at least one provider (abstract).

As per claims 15, 25 and 26, Bellesfield teaches the request including a location of interest and a distance to the location of interest (abstract).

As per claim 18, 20, 29 and 31, Bellesfield teaches accessing a database for a geocode corresponding to a destination of interest (figure 7).

As per claims 19 and 30, Bellesfield teaches the routing component 46 searches for the departure point in the "place name" field of the routing places data in the routing database 30.

As per claim 21, Bellesfield teaches storing the retrieved information in a searchable database (figure 7).

Claims 16, 17, 23, 24, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellesfield et al (6,498,982) in view of DeLorme et al (5,948,040).

As per claims 16, 23 and 27, Bellesfield does not teach how to purchase or specifying a dollar limit. However, DeLorme teaches the user buying tickets (column 14, lines 25-30). Therefore, it would have been obvious to one skill in the art to combine the aforementioned inventions in order to construct a travel route that incorporates waypoints selected by the user.

As per claims 17, 24 and 28, Bellesfield does not teach the number of travelers departing. However, DeLorme teaches the user making reservations and buying various tickets. Therefore, it would have been obvious to one skill in the art to combine the aforementioned inventions in order to construct a travel route that incorporates waypoints selected by the user.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga Hernandez whose telephone number is 571-272-7144. The examiner can normally be reached on Mon-Thu 7:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

A handwritten signature in black ink, appearing to read 'Olga Hernandez', with a large loop at the end.

Olga Hernandez
Examiner
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